



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/383,508	08/26/99	RYAN	P AMDA.389DIV1

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PM82/0322

EXAMINER

RODRIGUEZ, J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED:

03/22/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/383,508

Applicant(s)

RYAN ET AL.

Examiner

Joseph C Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Response to Amendment

The 35 U.S.C. 112 rejections are maintained and modified as follows:

1. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph. Examiner is not persuaded by Applicants argument that Applicants failure to discuss conventional aspects of an unclaimed feature does not violate §112, or that the specification does in fact teach critical issues of reticle sorting, thus enabling the specification under §112.
2. To be enabling, the specification must allow any person skilled in the art to make and use the claimed invention without undue experimentation. See In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (1988); see also MPEP §2164.01. In the instant invention, Applicants broadly claim a sorting system adapted for holding and sorting multiple cassettes, wherein each cassette contains a plurality of reticles. To make and use such an invention, Applicants must resolve critical issues of semiconductor fabrication such as protecting the particles from foreign particles, orienting the reticles, and stabilizing the reticles during the sorting process. Applicants citation to specific portions of the specification that partly deal with these issues are still non-enabling. Applicants specification only teaches how to resolve the critical issues on an elementary level; however, Applicants claimed invention, which alleges the ability to perform multiple handling functions, nearly simultaneously, on several reticle cassette libraries requires further enablement in order to properly resolve said critical issues. That is, the issues of protecting, handling, and orienting the reticles are multiplied by the complexity of Applicants claimed invention, thus one skilled in the art would require undue

experimentation to properly make and use the claimed invention. The need for undue experimentation and more direction from the inventor is especially apparent when comparing Applicants inadequate disclosure to the enabling disclosures of similar inventions, such as Sussman, Iizuka, Rosenquist, and Umatate. In these similar inventions, the disclosures contain considerable detail for each specific method of reticle handling. Moreover, these disclosures are not readily applicable to Applicants more complex invention without undue experimentation. Consequently, Applicants specification is not enabling.

3. Claims 1, 8, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph. Although Applicants have purportedly amended the cited claims to more clearly define the claimed invention, Applicants insertion of the phrase "adapted" has rendered the cited claims indefinite. The use of the phrase "adapted" has no clear technical meaning. Moreover, it does not constitute a limitation in any patentable sense. See In re Hutchison, 69 USPQ 138 (CCPA 1946). That is, the use of the phrase "adapted" renders the subsequent phrasing irrelevant and without patentable weight. Id. Consequently, the scope of Applicants claims are unascertainable and are rejected under §112, second paragraph.

The prior art rejections are maintained as follows:

4. Claims 1, 3, 5, 7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizuka in view of Sussman as argued in the prior action. Applicants

argument that Sussman does not disclose the claimed limitations as cited by Examiner are unpersuasive.

Sussman was originally cited as disclosing a device that interfaces with multiple reticle libraries, that uses a holding location during the sorting operation, and that retrieves and inserts the reticles to and from the cassette slots when sorting. However, Applicants use of the phrasing "adapted" has, as explained supra, rendered portions of Applicants claims to be without patentable weight. In particular, the limitations contained after the phrasing "adapted" in claims 1 and 11 have eliminated the need, to find within Sussman, the limitation of a sorting system that retrieves and inserts reticles between multiple cassette slots during sorting. Applicants own amendments have thus rendered moot Applicants own arguments with regards to the Sussman art rejection. Further, a stated motivation need not be explicit in the cited art to exist as a motivation. Consequently, the rejections are maintained.

5. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizuka and Sussman as applied to claims 1, 3, 5, 7, and 9-12 above, and further in view of Umatate. Applicants argument that Umatate does not disclose the claimed limitations as cited by Examiner are unpersuasive.

6. Applicants own amendments to claims 1 and 8 have again rendered moot Applicants own arguments with regards to the prior art not containing the claimed limitations. As the claims have been amended to eliminate the claimed limitations at issue, it is unnecessary for Examiner to address the validity of Applicants arguments

pertaining to the claims addressed in the first action. Consequently, the rejections are maintained as previously stated.

7. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizuka and Sussman as applied to claims 1, 3, 5, 7, and 9-12 above, and further in view of Rosenquist. Applicants argument that the asserted combination does not read on the claimed invention and that the stated motivation is not evidenced in the cited art are unpersuasive.

8. In particular, Applicant argues that "the asserted combination does not teach or suggest the use of the arm to sort reticles within the cassette." Claim 4, however, only claims a sorting system that "includes an arm with claws for grasping the reticles." Thus, Applicant has misstated his own limitation. Moreover, Applicants have even conceded that the use of a sorting arm is known in the reticle sorting art (Amndt, p.3). Further, Sussman teaches, inter alia, that the use of a arm with grasping claws is well known in the reticle sorting art. Therefore, the rejections are maintained as previously stated.

9. Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is 703-308-8342. The examiner can normally be reached on M-F during business hours, with alternate Mondays off.

The fax phone number for the organization where this application or proceeding is assigned is 703-306-4194.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

March 21, 2001


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600